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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,409	03/20/2001	Nicholas Paul Andrew Galea	U 013324-3	2440

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EXAMINER

DADA, BEEMNET W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,409

Applicant(s)

GALEA, NICHOLAS PAUL
ANDREW

Examiner

Beemnet W Dada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application:
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in reply to an amendment filed on November 22, 2004. Claims 1-30 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1- 6, 11-15, 17-20 and 26-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Ji et al US Patent 5,889,943 (hereinafter Ji).
4. As per claim 1 and 15, Ji teaches an anti-virus system for an electronic mail message [see abstract], the system including detecting means for determining the presence of the electronic mail message [column 11, lines 51-53, and column 8, lines 42-67]; analysis and scanning detecting means for analysing and scanning the electronic mail message for tags (for example for file extensions, and/or portions of messages that begin with a line such as 'begin filename' and end with a line such as 'end' ") indicating the presence of operable program code [col. 11, line 53–col. 12, line 3, and col. 8, line 50–col. 9, line 3, col. 12, lines 18-31] and for removing any such tags and operable program code from the electronic mail message [col. 12,

lines 47-49, 56-58]; and application means for applying the electronic mail message, with the tags and operable program code removed, to server means [col. 12, lines 47-49, 56-58].

5. As per claims 2 and 17, Ji teaches the system as applied above. Ji further teaches the system wherein a message body part is scanned for viruses [column 11, lines 54-67 and column 12, lines 1-14] and an attachment part of the message is scanned for viruses [column 19, lines 40-67 and column 20 lines 1-27].

6. As per claims 3 and 18, Ji teaches the system as applied above. Ji further teaches the scanning means comprise scanning means for scanning the message for predetermined character strings [column 11, lines 59-63].

7. As per claims 4-5 and 19-20, Ji teaches the system as applied above. Ji further teaches replacement means for replacing the removed tag and operable program code with alternative text [column 12, lines 54-57].

8. As per claims 6, Ji teaches the system as applied above. Ji further teaches scanning means for scanning attachments for operable macros [col. 11, line 53—col. 12, line 3, and col. 8, line 50—col. 9, line 3, col. 12, lines 18-31].

9. As per claims 11 and 12, Ji teaches the system as applied above. Ji further teaches the scanning means comprise scanning means for scanning the message for predetermined character strings [column 11, lines 59-63].

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10. As per claims 13-14 and 26-27, Ji teaches the system as applied above. Ji further teaches capturing electronic messages passing between a first network and a second network [column 11, lines 50-57].

11. As per claims 28-30, Ji teaches the system as applied above. Ji further teaches a computer program comprising code means for performing all the steps of the method of claim 15 when the program is run on one or more computers [column 3, lines 13-18].

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7-10 and 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ji US Patent 5,889,943 in view of Kim et al. US Patent 6,701,440 (hereinafter Kim).

14. As per claims 7, 16 and 21, Ji teaches the system as applied above. Ji further teaches storing encode portions of a message containing viruses in a specified directory [column 12, lines 49-54]. Ji does not explicitly teach quarantining an attachment containing a macro or operable program code. However, kim teaches a remote e-mail scanning device [see abstract], including quarantine means for quarantining a constituent body containing operable program code and/or removing from the message and quarantining an attachment containing a macro or

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operable program code [column 8, lines 57-67 and column 9, lines 1-19]. Both Ji and Kim teach an anti-virus system for electronic messages. It would have been obvious to one having ordinary skill in the art at the time of the applicant invention to modify the teachings of Kim within the system of Ji in order to enhance the security of the system by quarantining messages containing operable program code.

15. As per claim 8, the combination of Ji and Kim teach the system as applied above. Furthermore, Kim teaches the system wherein the quarantine means includes means for removing a macro from an attachment, quarantining the macro and releasing the attachment with the macro removed [column lines 8, 57-67 and column 9, lines 1-19].

16. As per claims 9 and 22, the combination of Ji and Kim teach the system as applied above. Furthermore, Kim teaches the system wherein the quarantine means includes means for storing the constituent body, attachment or macro in a quarantine storage location as a quarantined item, receiving means for receiving a input indicating a decision whether the quarantined item may be delivered to an intended recipient, and dependant on the decision input either releasing the quarantined item for delivery to the intended recipient with or without the operable code removed or deleting the quarantined item [column 8, lines 57-67 and column 9, lines 1-29].

17. As per claims 10 and 23, the combination of Ji and Kim teach the system as applied above. Furthermore, Kim teaches the system wherein the quarantine means includes informing means, on deleting the quarantined item, for informing the intended recipient and/or a sender of

the message that the quarantined item has been deleted without being delivered to the intended recipient [column 9, lines 1-29].

18. As per claim 24, the combination of Ji and Kim teach the system as applied above. Furthermore, Kim teaches the system wherein the scanning means for scanning attachments for operable macros comprises means for sequentially scanning the attachments for a plurality of predetermined character strings [column 1, lines 30-37 and column 5, lines 30-34].

19. As per claim 25, the combination of Ji and Kim teach the system as applied above. Furthermore, Kim teaches the system wherein the means for scanning attachments for a plurality of predetermined character strings includes termination means for terminating scanning when one of the predetermined strings is not found on completely scanning the attachment [column 1, lines 30-37 and column 5, lines 30-35].

Response to Arguments

20. Applicant's arguments filed November 22, 2004 with respect to Ji US Patent 5,889,943 have been fully considered but they are not persuasive. Applicant argues that Ji fails to teach scanning electronic message for tags indicating the presence of operable program code and replacing a removed tag and operable program code. Examiner respectfully disagrees.

Ji teaches scanning an electronic mail message for tags (for example for file extensions, and/or portions of messages that begin with a line such as 'begin filename' and end with a line such as 'end' ") indicating the presence of operable program code [col. 11, line 53—col. 12, line 3, and col. 8, line 50—col. 9, line 3, col. 12, lines 18-31] and for removing any such tags and operable

program code from the electronic mail message [col. 12, lines 47-49, 56-58] which meets the recitation of the claims and Ji further teaches replacing the removed tag and operable program code with alternative text [column 12, lines 54-57].

21. Applicant's arguments, filed November 22, 2004 with respect to the rejection(s) of claim(s) 1 and 15 under 35 USC 102 (e) as being anticipated by Kim US Patent 6,701,440 B1 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) US Patent 6,230,288 B1 teaches method of treating white space during virus detection.

b) US Patent 5,951,698 teaches system for detection and removal of viruses in macros.

c) US Patent 6,697,950 B1 teaches method and apparatus for detecting a macro computer virus using static analysis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Beemnet Dada

March 12, 2005

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